



Exhibit "A"

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

APPLICANT(s): Schwartz, R.

SERIAL NO.: 09/308,451

ART UNIT: 2175

FILING DATE: 5/19/99

EXAMINER: Rimell, S.

TITLE: TECHNIQUE FOR EFFECTIVELY GENERATING MULTI-  
DIMENSIONAL SYMBOLS REPRESENTING POSTAL  
INFORMATION

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DOCKET NO.: 770P009580-US (PAR)

Board of Appeals and Interferences

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ATTENTION: BOARD OF PATENT APPEALS AND INTERFERENCES

APPELLANTS' BRIEF  
(37 C.F.R. §41.37)

This is an appeal from the final rejection of the claims in the above-identified application. A Notice of Appeal was mailed on November 30, 2004.

**I. REAL PARTY IN INTEREST**

The real party in interest in this Appeal is:

Ascom Hasler Mailing Systems, Inc., a division of Neopost,  
S.A.

**II. RELATED APPEALS AND INTERFERENCES**

None

### **III. STATUS OF CLAIMS**

Claims 1, 4-7, 10-13, 17-21, 24-33, 40-44, 89-102 and 106 are pending in the application.

Claims 1, 4-7, 10-13, 17-21, 24-33, 40-44, 89-102 and 106 have been finally rejected.

The claims on appeal are 1, 4-7, 10-13, 17-21, 24-33, 40-44, 89-102 and 106.

Claims 46-88 are withdrawn

### **IV. STATUS OF AMENDMENTS**

There was no response under 37 C.F.R. 1.116.

### **V. SUMMARY OF THE CLAIMED SUBJECT MATTER**

In a mailing system (p. 6, l.30; Fig.2, 201) for franking a postage indicium (p. 9, l. 1; Fig. 4, 400) serving as proof of postage (p. 9, l. 2) , postal data (p. 9, l. 15) including the postage (p.9, l. 2) needs to be communicated through such an indicium (400). Optionally, the postal data is categorized into (a) invariable postal data, e.g., a device ID identifying the mailing system, which is unaffected by a franking transaction, (p. 10, ll. 9-13) and (b) variable postage data, e.g., the postage, which may change from one franking transaction to another (p. 10, ll. 13-18).

Optionally, to speed up the franking operation, the invariable postal data is preset (Fig. 5A, 503; p. 11, ll. 26-27) for

initial printing of the postage indicium (Fig. 4, 400), and the variable postal data is determined (Fig. 5B, 550; p.15, l. 21, to p. 18, l. 12) and set for printing in real time (see p. 11, ll. 27-28). In printing the postage indicium (Fig. 4, 400), the invariable postal data and the variable postal data are optionally presented in that order (p. 10, ll. 19-28; Fig. 5A, 587) in one or more symbols (Fig. 4, 415, 420).

Optionally, as recited in claim 26, to further speed up the operation, certain data, e.g., mail classes and postage value, can be predicted using, e.g., statistical methods applied to past usage of mail classes and postage (Fig. 5B, 564; p.15, l. 35, to p. 16, l. 12) as recited in claim 29. In other words, if, e.g., several consecutive mailpieces have a certain postage, the following mailpiece is likely to have the same postage.

Optionally, as recited in claims 1, 7, 13, 20 and 40 the indicium can be printed by an apparatus (Fig. 7, 700) having first (Fig. 7, 703) and second (Fig. 7, 705) printheads (p. 19, ll. 16-18) which correspond to the symbol segments (Fig. 6, 610 and 620; Fig. 8, 810 and 820; p. 19, ll. 33-35 to p. 20, ll. 35-37). The printheads are separated by a gap (Figs 6 and 8 G; Fig. 7, G') which is a function of the size of a delimiter separating the segments (p. 20, ll. 1-6 and p. 20, l. 32 to p. 21, l.3). This has the advantage of compensating for mechanical tolerance and printhead alignment (p. 20, ll. 4-6). This also allows the printheads to be placed at different locations, e.g., top and bottom, in order to obtain printing in one pass as opposed to having the envelope pass in one direction and then

another under the printhead. In turn, this avoids moving the printhead over the envelope or moving the envelope under the paper.

#### VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Claims 1, 4-7, 10-13, 17-21, 24-33 and 89-102 stand rejected under 35 USC 102 as being anticipated by Schwartz.
2. Claims 40-44 and 106 stand rejected under 35 USC 103 as being obvious over Gilham in view of Official Notice.

#### VII. ARGUMENT

##### A. Claims 1, 4-7, 10-13, 17-21, 24, 25 and 89-102

Claim 1 recites that the postal data elements are 2-dimensional bar codes and that the first and second elements are separated by a delimiter. Similar limitations are in independent claims 7, 13, 20 and 40. While Figs. 6 and 7 of Schwartz show plain-text elements 605 and 705 respectively separated from barcode elements 610 and 710, there is no separation of first and second bar code elements as presently claimed. The Examiner has argued that since the first and second data elements are discrete fields, they must be separated by field delimiters in order to define discrete fields (see top of page 3 and bottom of page 7 of final rejection). However, Figs. 6 and 7 plainly show no delimiters; the fields are immediately adjacent each other. Apparently the Examiner is stating that Schwartz inherently produces delimiters. However, inherency is never presumed, and

it must be shown to be necessarily present in the thing described, and that it would be so recognized by persons of ordinary skill, see *Continental Can Co. USA Inc. v. Monsanto Co.*, 20 USPQ 2d 1746, 1749; 948 F. 2d 1264 (CAFC 1991). This is certainly not the case here where a delimiter is not present, nor would one be recognized by such a person.

Thus the rejection of claims 1, 4-7, 10-13, 17-21, 24, 25, 30-33, and 89-102 under 35 USC 102 on Schwartz should be reversed.

Further, since there is not the slightest suggestion of a delimiter in Schwartz, these claims are unobvious over it.

#### B. Claims 26-33

Claim 26 covers the prediction embodiment, e.g., using past usage of mail class and postage to predict the most likely class and postage. While it is true, as stated by the Examiner, that Schwartz discloses storage of a table of rates and postage, it is respectfully submitted that this storage is not determining first data based on a predicted version of second data as claimed. In other words, storage is not the same as prediction. The Examiner has stated (p. 7, penultimate paragraph) that claim 26 is directed to a static set of predicted data. However, there is nothing in this claim about the data being static. In fact, it is changing with, e.g., varying mail classes and postage. Further, since there is no predicted data in Schwartz, there can be no comparator for comparing actual data with the predicted data as is also claimed. In fact, there is no comparison of any kind in Schwartz.

Thus the rejection of claims 26-33 under 35 USC 102 on Schwartz should be reversed.

Further, since there is not the slightest suggestion in Schwartz of prediction and comparison, with the advantages of speed, avoiding multiple passes, efficient generation of error correction codes, and efficient use of space, these claims are unobvious over it.

B1. Claim 29

Claim 29 recites that the prediction is statistically determined, e.g., if a run of letters has the same postage, the next one is likely to have the same postage. The Examiner has argued that statistics are in the memory table of Schwartz. However, this table just has postage data which is not statistical determination. For this additional reason claim 29 is not anticipated by Schwartz.

Further since there is not the slightest suggestion in Schwartz of statistical determination, claim 29 is unobvious over Schwartz.

B2. Claim 33

Claim 33 recites that the processor includes the comparator. This is totally missing from, and not suggested by, Schwartz since there is no comparator in the first place. In particular, the Examiner states that the processor has software for making the comparison, but provides no reference as where in Schwartz this is found. For this additional reason claim 33 is not anticipated by Schwartz.

Further, since there is not the slightest suggestion in Schwartz of a comparator, claim 33 is unobvious over Schwartz.

C. Claims 40-44 and 106

As previously pointed out, claim 40 recites a 2-dimensional bar code segments separated by a delimiter. Gilham '903 totally fails to disclose this. In particular, while it is true that Gilham shows two printheads 28 and 31, there is no disclosure of a delimiter. Further, while barcodes are known, the Examiner cites absolutely no teaching of combining them with the printheads of Gilham. Apparently, the Examiner is relying on "common knowledge or common sense". However, this is not a proper basis for combining references, see *In re Lee*, 61 USPQ 2d 1430, 1434; 277 F.3d 1338. Still further, even if Gilham is somehow combined with Official Notice of the existence of bar codes, the result is not the invention of claim 40. In particular, in the resulting combination there still would not be delimiters between the bar code segments.

Thus the rejection of claims 40-44, and 106 under 35 USC 103 on Gilham in view of Official Notice should be reversed.

C1. Claim 44

This claim recites that the delimiter forms part of finder patterns. This is totally missing from either Gilham or Official Notice. Thus combining them does not result in claim 44. For this additional reason claim 44 is unobvious over this combination of references.

In conclusion the reversal of the rejection of all rejected claims is requested from this Honorable Board.

The appendix of claims is attached hereto. A check in the amount of \$340.00 is enclosed herewith for the appeal brief fee.

The Commissioner is hereby authorized to charge payment for any additional fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,

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I hereby certify that this correspondence is being deposited with the United States Postal Service on the date indicated below as first class mail in an envelope addressed to the BOARD OF PATENT APPEALS AND INTERFERENCES, P.O. Box 1450, Alexandria, VA 22313-1450,

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# VIII. CLAIMS APPENDIX

The texts of the claims involved in the appeal are:

1. Apparatus for processing a plurality of 2-dimensional bar code postal data elements, a first one of the plurality of postal data elements being a function of at least a second one of the plurality of postal data elements, the apparatus comprising:

a processor for arranging the plurality of 2-dimensional bar code postal data elements in an order where the second postal data element precedes the first postal data element; and

an output for providing a representation representing the plurality of postal data elements in the arranged order, said first and second elements being separated by a delimiter.

4. The apparatus of claim 1 wherein the representation includes at least one data matrix symbol.

5. The apparatus of claim 1 wherein the second data element concerns a postage value, and the first data element concerns a descending register value.

6. The apparatus of claim 1 wherein the representation includes a bit map for a print image of at least one coded symbol representing the plurality of data elements.

7. Apparatus for processing a plurality of 2-dimensional bar code postal data elements, the apparatus comprising:

a processor for arranging the plurality of 2-dimensional bar code postal data elements in an order such that each postal data element preceding a second postal data element is independent of the second postal data element; and

an output for providing a representation representing the plurality of postal data elements in the arranged order, said first and second elements being separated by a delimiter.

10. The apparatus of claim 7 wherein the representation includes at least one data matrix symbol.

11. The apparatus of claim 7 wherein one of the plurality of the data elements concerns a postage value.

12. The apparatus of claim 7 wherein the representation includes a bit map for a print image of at least one coded symbol representing the plurality of postal data elements.

13. Apparatus for conducting a postage franking transaction to generate a representation representing data, the apparatus comprising:

a processor for identifying a first subset of the data which is unaffected by the postage franking transaction and a second subset of the data which is subject to change during the postage franking transaction; and

an output for providing a representation representing the first subset of the data and the second subset of the data, the representation being partitioned into a first part and a second part thereof, said parts being separated by a delimiter, the first subset of the data and the second subset of the data being represented by the first part and the second part, respectively, wherein the representation includes two coded 2-dimensional bar code symbols separated by said delimiter.

17. The apparatus of claim 13 wherein the coded symbol includes a data matrix symbol.

18. The apparatus of claim 13 wherein the representation includes a first coded symbol and a second coded symbol, the first part including at least part of the first coded symbol.

19. The apparatus of claim 18 wherein the second part includes at least part of the second coded symbol.

20. Apparatus for conducting a postage franking transaction, the apparatus comprising:

a processor for processing a plurality of data elements; and

an output for generating at least a first symbol and a second symbol representing the data elements, at least part of the first symbol representing a first subset of the data elements which is unaffected by the postage franking transaction, and at least part of the second symbol representing a second subset of the data elements which is subject to change during the postage franking transaction, said first and second symbols being 2-dimensional bar codes separated by a delimiter.

21. The apparatus of claim 20 wherein the first symbol is generated before the second symbol.

24. The apparatus of claim 20 wherein at least one of the first and second symbols includes a data matrix symbol.

25. The apparatus of claim 20 wherein the output includes a printer.

26. Apparatus for generating a postage indicium based on at least first data, the first data being a function of second data, the apparatus comprising:

a processor for determining at least one candidate for the first data based on a predicted version of the second data;

a comparator for comparing an actual version of the second data with the predicted version thereof; and

an output for generating the postage indicium based on the candidate for the first data when the actual version matches the predicted version.

27. The apparatus of claim 26 wherein the second data concerns a postage value.

28. The apparatus of claim 27 wherein the second data also concerns a mail class.

29. The apparatus of claim 26 wherein the predicted version of the second data is statistically determined.

30. The apparatus of claim 26 wherein the predicted version of the second data includes a postage value indicated in the last postage indicium generated by the apparatus.

31. The apparatus of claim 26 wherein the first data concerns a code for authenticating the postage indicium.

32. The apparatus of claim 31 wherein the code includes at least part of a digital signature.

33. The apparatus of claim 26 wherein the processor includes the comparator.

40. Apparatus for printing a symbol representing data, the data being disposed in at least a first segment and a second segment in the symbol, said first and second segments being 2-dimensional bar codes, the first segment being separated from the second segment by a delimiter, the apparatus comprising:

at least a first printhead and a second printhead for printing the first and second 2-dimensional bar code symbol segments, respectively, the first printhead being separated from the second printhead by a gap, the size of the gap being a function of the size of the delimiter.

41. The apparatus of claim 40 wherein the symbol includes a data matrix symbol.

42. The apparatus of claim 41 wherein the data matrix symbol is formatted in a dark on light format.

43. The apparatus of claim 41 wherein the data matrix symbol is formatted in a light on dark format.

44. The apparatus of claim 41 wherein the data matrix symbol includes finder patterns, and the delimiter forms part of the finder patterns.

89. The apparatus of claim 1, wherein said output includes a printer for printing said representation upon a mailpiece.

90. The apparatus of claim 89, further comprising the mailpiece.

91. The apparatus of claim 1, further comprising a mailpiece having said representation thereon.

92. The apparatus of claim 7, wherein said output includes a printer for printing said representation upon a mailpiece.

93. The apparatus of claim 92, further comprising the mailpiece.

94. The apparatus of claim 7, further comprising a mailpiece having said representation thereon.

95. The apparatus of claim 13, wherein said output includes a printer for printing said representation upon a mailpiece.

96. The apparatus of claim 95, further comprising the mailpiece.

97. The apparatus of claim 13, further comprising a mailpiece having said representation thereon.

98. The apparatus of claim 25, further comprising the mailpiece having said symbols thereon.

99. The apparatus of claim 20, further comprising a mailpiece having said symbols thereon.

100. The apparatus of claim 26, further comprising a mailpiece having said indicium thereon.

101. The apparatus of claim 26, wherein said output includes a printer for printing said indicium upon a mailpiece.

102. The apparatus of claim 101, further comprising the mailpiece.

106. The apparatus of claim 40, further comprising a medium having said symbol thereon.



IX. EVIDENCE APPENDIX

Not Applicable

X. RELATED PROCEEDINGS APPENDIX

Not Applicable